

REMARKS

This Response is made to the Office Action dated April 18, 2008. Claims 1-5 and 7-20 are pending in this application. Favorable consideration of all of the pending claims is respectfully requested in view of the remarks below.

Claims 1-5 and 7-20 were rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 5,792,144 to Fischell (the "Fischell patent") in view of U.S. Patent No. 5,147,379 to Sabbaghian (the "Sabbaghian patent"). Applicants, however, strongly disagree with the Examiner's position. First and foremost, the Fischell patent is directed to a catheter in which the sheath 61 is **prevented** from rotating about an inner member 71. Additionally, the outer sheath 61 is adapted to **only move longitudinally a sufficient distance** to uncover the stent 40. The Fischell patent states the following:

It should be noted that the slot 62 and key 67 cooperate to prevent the distal section of the sheath 61 from rotating about the dual-lumen tube 63. The length of the slot 62 is sufficient to allow the thin-walled tube 36 to be pulled back far enough to completely uncover the stent 40. (Column , lines)

The Fischell patent thus teaches the importance to prevent rotation and limit longitudinal movement of the sheath 61 relative to the inner member 71.

The Sabbaghian patent only teaches that a leaf spring 25 can be used to prevent longitudinal movement of an inner member 5 relative to an outer member 16. The leaf spring 25 and the annular channel 33 formed on the outer member 16 do not prevent rotational movement of the inner member 5 relative to the outer member 16. The bent lock section 34 of the spring 25 simply rides in this annular channel 33 and would not prevent rotation between the inner member 5 and the outer member 16. Moreover, this structure does not limit the amount of longitudinal motion between the inner member 5 and the outer member 16. Rather, the function of this spring is to prevent motion of the inner member 5 in either longitudinal direction until it is desired to do so. (See Column 5, lines 44-47). Therefore, the spring 25 used in the Sabbaghian patent is used only as a locking means for preventing relative motion between the inner member 5 and the outer member 16.

Applicants submit that the Examiner has simply selected the Sabbaghian patent because it shows the use of a leaf spring with movable components. The Examiner's position requires one skilled in the art to completely disregard the teachings of the Fischell patent concerning the need to prevent rotational movement and limit longitudinal movement between the inner and outer members. Given these teachings of the Fischell patent, it would seem incongruous for one skilled in the art to simply substitute the leaf spring of the Sabbaghian patent with the key 67 of the Fischell patent. Again, the Fischell patent teaches one skilled in the art to prevent rotational movement and limit free longitudinal motion between the moving components. Therefore, one reading the Fischell patent would not want to replace the key 67 with the leaf spring 25 of the Sabbaghian patent. Given the Examiner's combination and position, Applicants believe that the Examiner has simply used the claims as a roadmap and has simply selected patents which appear to have the elements of the claims without giving due consideration of the teachings of these patents. Accordingly, Applicants believe that the Examiner has used impermissible hindsight in recreating the presently claimed invention. Applicants respectfully request the Examiner to withdraw the obviousness rejections of these claims.

Applicants further submit that the correct combination of the teachings of the Sabbaghian patent with the Fischell patent would result in one skilled in the art merely placing a leaf spring at the proximal end of the Fischell catheter to act as a locking mechanism to prevent motion between the inner and outer members until such motion is desired. This is the function of the leaf spring/annular channel of the Sabbaghian patent. Currently, the Fischell catheter apparently lacks any locking mechanism to prevent the inner member from moving longitudinally with the outer member. The locking mechanism of the Sabbaghian patent, i.e., the leaf spring 25 and annular channel 33, would allow the physician to lock the member in place and then to disengage the leaf spring 25 when motion is desired, as is done and taught in the Sabbaghian patent. This addition of a leaf spring 25 to the proximal end of the Fischell catheter would thus allow the physician the benefits of the Fischell patent in still preventing rotational movement and limiting longitudinal movement of the inner and outer members while providing a

locking mechanism as taught by the Sabbaghian patent. Therefore, Applicants maintain that a correct combination of the Fischell patent with the Sabbaghian patent fails to create the structure of the presently claimed invention.

Applicants note that many of the dependent claims contain structural elements which do not appear to be found in the Fischell patent. For example, claims 2, 12 and 17 further requires a tubular sleeve defining a lumen that is positioned externally around and coaxially aligned with the inner member. The expanding member/leaf spring is required to have opposing ends with the ends being positioned within the sleeve lumen. Applicants have been unable to find such structure in the Fischell patent. Claim 11 further requires the outer member to deform the expanding member when the outer member is moved axially in relation to the inner member. Again, the Fischell patent teaches to allow only limited longitudinal movement between the inner member and outer member. The Sabbaghian patent does so as well. Moreover, the Sabbaghian patent requires one to push the leaf spring 25 to disengage the lock section 34 from the annual channel 33. Once the lock section 34 is placed in the channel, there is no relative movement between the inner and outer members. Therefore, since there is no movement of the outer member when the leaf spring 25 is locked in place, the outer member would be incapable of deforming the leaf spring 25. One has to use one's hand to depress the leaf spring 25 in the Sabbaghian device. Therefore, the particular structure recited in claim 11 is not found in either the Fischell or Sabbaghian patent. Lastly, claim 5 requires the wall thickness of the edges of the opening being greater than the average thickness of the wall over the length of the outer member. Applicants have been unable to find support for this structure in either the Fischell or Sabbaghian patent. For these additional reasons, Applicants respectfully request the Examiner to withdraw the obviousness rejections of these claims.

In view of the foregoing, it is respectfully urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at 310-824-5555 to facilitate prosecution of this application, if necessary.

In light of the above amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case. The Commissioner is hereby authorized, however, to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 06-2425.

Respectfully submitted,
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